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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,045	11/29/2001	Flemming Boegelund	AUS920010934US1	6053
7590	03/14/2005		EXAMINER	
Intellectual Property Law Department IBM Corporation 11400 Burnet Road Austin, TX 75758			BAYERL, RAYMOND J	
			ART UNIT	PAPER NUMBER
			2173	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/998,045	BOEGELUND, FLEMMING	
	Examiner	Art Unit	
	Raymond J. Bayerl	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 January 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 - 15, 17 - 21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 6 - 10, 12 - 15, 17 - 21 is/are allowed.
 6) Claim(s) 1 - 5, 11 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 15 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2173

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

"The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words."

Applicant's abstract deviates from these guidelines by comprising two paragraphs.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what applicant intends to be the invention, when claim 11 is recited as "using the length obtained in claim 10". Claim 10 is not given as a parent claim in dependent claim format, so if claim 11 is intended as a dependent, what part of claim 10 is in fact incorporated by this reference? Applicant should compare claim 11 with comparable claim 21, which is actually a dependent of a parent claim in which "the length" is found.

4. Claims 1 – 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar et al. ("Kumar"; US #6,356,921 B1) in view of Miller et al. ("Miller"; US #2004/0080525 A1).

As per independent claim 1's "appending information to a graphical image file", Kumar discloses that HIERARCHICAL AND ADAPTIVE DELIVERY RICH MEDIA

PRESENTATIONS AND ASSOCIATED META DATA may be contained within a single file that contains all information for a complete presentation (Abstract). This presentation file can contain a file header frame and multiple media frames, and also a thumbnail description. In working with Media bit streams (col 9, lines 29 – 49), Kumar, beginning with JPEG frames (a “graphical image file of said created graphical image”) will develop “an appendix to the graphical image file” that enables the additional presentation functionality, as in figs 1, 6A, 7.

Kumar’s file structure is described in general terms relating to object linking within a rich media environment (col 2, lines 7 – 31), and does not enter into a depth of discussion such as “defining an area on the created image as a hotspot area”. However, Miller’s OBJECT SELECTION USING HIT TEST TRACKS is specifically directed to producing a selected visual area (Abstract; fig 2b) that is linked to at least one image frame, the resultant information being stored within a labeled portion of memory.

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant’s invention to code a “hotspot” with the hit test track of Miller (see also paragraph 0020), within the single file arrangement of Kumar’s presentation, so that regions within Kumar’s rich media might be made precisely controlled as to how they are linked to other information resources.

As per claim 2, “appending the generated appendix” is part of the general single file arrangement in Kumar, as is the incorporation of “a JPEG file format” (claim 5), as noted above.

Claim 3's use of "an image creation tool" (this also being claim 4's "external tool") is specifically a part of Miller's labeling the pixels: via pattern recognition techniques or through manual object tracking (paragraph 0033).

5. Applicant's arguments filed 3 January 2005 have been fully considered but they are not persuasive.

Applicant, after noting at page 10 of the remarks that the "present invention is based on the idea of storing that further information inside the actual image", argues that "Kumar and Miller talk about new file formats that need new applications to be using the files, so they are not backwards compatible with existing applications." However, this neglects the actual substance of the claims, and the Examiner is not permitted to "read in" limitations from the specification. In claim 1, "a graphical image file" has attached to it "an appendix" "containing the information about the defined hotspot area". There is nothing in such a claim to call for incorporation of the "appendix" material into some form of "backwards compatible" format; that of "the actual image". Thus, Kumar and Miller continue to read upon attaching an "appendix" describing a "hotspot" to a "graphical image file", as appears in claims 1 – 5.

Applicant, in noting that Miller "does not mention or discuss any application of this technology to presentations", argues that "[t]here is nothing in Miller to suggest the combination of Miller with Kumar". However, motivation remains in the kind of media arrangement seen in Kumar for the support of "hotspot area" designations, for inclusion into the single file that includes original imagery. Hotspots are eminently useful in any form of interactive presentation involving graphics, and thus, the Miller-style appendage

of a "hotspot" description would indeed have been obvious to the person having ordinary skill in the art.

6. Claims 6 – 15, 17 - 21 are allowable over the prior art now made of record.

Please note that the above-noted uncertainty under 35 USC 112 must be rectified, concerning claim 11.

Dependent claims 6 – 11 had been indicated as allowable over the prior art of record in the previous Office action; applicant has now placed parent claim 6 of this group in independent claim form.

Dependent claim 16 had been indicated as allowable as well in the previous Office action; applicant has incorporated its limitations into parent claim 12, from which claims 13 – 15, 17 – 21 depend.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

During an update search, the Examiner noted that Lerner et al. (US #6,859,909 B1) relates to the attachment of annotations to a Web-based document (i.e., a document that is compatible with existing web-browsers)

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8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173
10 March 2005